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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,788	10/17/2003	Shamci Monajembashi	SHA-001	9873

3897 7590 04/18/2006

SCHNECK & SCHNECK  
P.O. BOX 2-E  
SAN JOSE, CA 95109-0005

EXAMINER
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WHALEY, PABLO S

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/687,788	<b>Applicant(s)</b> MONAJEMBASHI, SHAMCI	
	<b>Examiner</b> Pablo Whaley	<b>Art Unit</b> 1631	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

**Group I:** Claims 1-15 drawn to a sample, classified in class 702, subclass 019. If this Group is elected, then the below summarized specie elections are also required.

**Group II:** Claims 16-29 drawn to a method and system for producing optically induced mechanical forces on a target object, classified in class 702, subclass 19. If this Group is elected, then the below summarized specie elections are also required.

The inventions are distinct and divergent, each from the other because of the following reasons:

The invention of Groups I and II are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of Groups I and II have different effects. Group I, unlike Group II, is drawn to a sample comprising target objects and auxiliary objects. The sample of Group I could be used in any number of other cellular-based biotechnology applications, such as magnetic twisting cytometry for example. Group II, unlike Group I, is drawn to a method and system for producing optically induced mechanical forces on a target object, comprising optical tweezers and a microscope. Therefore, the burden of search is maintained as the examination process requires a search of non-patent literature, U.S. patent publications, U.S. patents, as well as foreign patent literature.

### **SPECIE ELECTION REQUIREMENT**

This application contains claims directed to patentably distinct and divergent species of the claimed inventions. If Group I is elected, the applicant is further required to elect a single species from species A, below, for purposes of examination. If Group II is elected, the applicant is further required to elect a single species from species B, below, for purposes of examination.

#### **Specie A:**

Species of auxiliary objects are cited in claims 2, 3, and 10, which are generally separately classified and published, and thus document undue search burden if searched together. Thus applicants are required to elect ONE of the following species of auxiliary objects:

- i. haemoglobin like protein body
- ii. muscle haemoglobin
- iii. colloidal polymer microcapsule

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from those listed above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic to the above species.

#### **Specie B:**

Species of laser beams are cited in claims 27 and 28, drawn to distinct laser beam configurations which are generally separately classified and published, and thus document undue search burden if searched together. Thus applicants are required to select one type of laser beam configurations from the following list:

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- i. coupled directly into beam passage
- ii. coupled into beam passage via a system of lenses

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from those listed above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 21 is generic to the above species.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from those listed above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 21 are generic to the above species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Whaley whose telephone number is (571)272-4425. The examiner can normally be reached on 9:30am through 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on (571)272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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ARDIN H. MARSCHEL  
SUPERVISORY PATENT EXAMINER